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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/853,036	05/11/2001	Masayuki Tani	P66643US0	5080
136	7590	11/17/2004	EXAMINER	
JACOBSON HOLMAN PLLC 400 SEVENTH STREET N.W. SUITE 600 WASHINGTON, DC 20004			GEREZGHER, YEMANE M	
			ART UNIT	PAPER NUMBER
			2144	

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/853,036

**Applicant(s)**

TANI, MASAYUKI

**Examiner**

Yemane M Gerezgiher

**Art Unit**

2144

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5-8.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Art Unit: 2144

**DETAILED ACTION**

1. This application has been examined. Claims 1-17 are pending.

**Claim Rejections - 35 USC § 102**

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-4, 9, 10, 12, 14-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Hayward et al. (U.S. Patent Number 6,798,997) hereinafter referred to as Hayward.

As per claims 1, 4, 12 and 16, Hayward disclosed an automatic consumable goods ordering system having therein a server on the supplier side connected to the server that manages the apparatus connected via the network (See Column 9, Lines 33-46). Hayward taught monitoring conditions of consumable goods in the printer that may "indicate a need to replace a consumable item or part (e.g., paper, ink, toner, cartridge, printhead,

Art Unit: 2144

drum). Using the sensed indicia from registration, an automatic electronic customer direct supply ordering mechanism can advantageously identify a replacement part or consumable item that is needed and the proper part can then be automatically ordered and sent to the user" (See Column 5, Lines 6-12) and Hayward further disclosed features including scheduling a delivery of consumable goods used by the apparatus. See Column 1, Line 47 through Column 2, Line 63, Column 9, Lines 38-43 and Column 9, Lines 21-33. Hayward disclosed different features including scheduling a delivery of consumable goods to be used by the apparatus (printer) in accordance with the sensed/monitored level of the consumable goods. See Column 1, Line 47 through Column 2, Line 63, Column 9, Lines 38-43 and Column 9, Lines 21-33. Hayward disclosed an automated electronic order system providing consumable products including consumable goods/components, monitoring the condition or level status of the consumable goods with in the printer and upon identifying a particular situation/condition of the consumable component, automatically communicates an electronic inquiry or an electronic offer to purchase a replacement of the consumable component. The consumable goods providing system identifies and electronically communicates a condition of the consumable part and communicating the condition of the consumable good/part to a

Art Unit: 2144

user, supplier, or third party. See Column 1, Lines 47 through Column 2, Line 4,). (Hayward teaches monitoring conditions in the printer that may "indicate a need to replace a consumable item or part (e.g., paper, ink, toner, cartridge, printhead, drum). Using the sensed indicia from registration, an automatic electronic customer direct supply ordering mechanism can advantageously identify a replacement part or consumable item that is needed and the proper part can then be automatically ordered and sent to the user". See Column 5, Lines 6-12. Hayward disclosed if the information is already present in the memory of computer 30. If the information is not present, the application program in step S23 launches an embedded or an external communications browser to access the manufacturer's server or vendor's server at an address defined by the peripheral condition. For example, the address might be: `www.manufacturer.com/product/xxx`, where "product" is the peripheral indicia or something derivative therefrom, and "xxx" is the peripheral condition (i.e., magenta ink level low), code, or something derivative therefrom). See Column 6, Lines 38-48. Hayward disclosed:

Application module including a monitor module that is called each time a job is sent to the printer to track how many pages have been printed and/or how much ink has been

Art Unit: 2144

expended in each color since the last time the consumable has been replenished. The monitor module includes an "inventory sub-module" to recorded each time the consumable has been replenished and to deduct consumption of the consumable as the jobs are printed. The monitor module causes an indication of a status condition to be displayed when the consumables are expected to be below a threshold based on the inventory sub-module ... server 40 is kept aware of the level of inventory on hand at the retailer, and can confirm availability before sending the shipment order to the retailer" (See Column 8, Lines 36-53).

Hayward further taught determining different levels of the measurement of the consumable parts/goods by using a software module and sensor system electronically monitoring the condition of the consumable part(s); sending a signal relating to the condition of the consumable part to a device; and electronically communicating an offer to purchase a consumable part at an occurrence of one of the first condition, intermediate condition, or third condition, ... initiating an electronic communication of an offer to purchase a replacement for the replaceable part upon identification of a threshold condition in the replaceable

Art Unit: 2144

part and ... initiating a purchase order defined by the condition (See Column 2, Lines 10-24, Lines 40-45 and Lines 56-61).

As per claim 2, Hayward disclosed using the apparatus or the printer's condition of the consumable goods to schedule delivery of replacement consumable goods. See Column 5, Lines 6-12 and Column 9, Lines 30-32.

As per claim 3, Hayward taught the apparatus been a printer (See Column 9, Lines 38-43), and where the supplier/ provider scheduling delivery of consumable goods based on the monitored condition of the consumable goods in the printer device (See Column 5, Lines 6-12 and Column 8, Lines 26-31) and further where the measurement of the consumable goods indicating multiple conditions as also presented in claim 13. See Column 2, Lines 10-16.

As per claim 9, Hayward disclosed consumable goods having therein a record medium containing information of the consumables. (See Column 4, Lines 32-46 and Column 7, Lines 60-66)

As per claim 10, Hayward disclosed a server of the supplier, which was able to access inventory situation of the consumable goods of a user (See Column 8, Lines 36-45).

As per claim 14, Hayward disclosed that one other feature including a maintenance service call from the printer requesting service/maintenance indicating the need of maintenance (See Column 6, Lines 60-64 and Column 7, Lines 37-53).

As per claim 15, Hayward disclosed the print server monitoring the printer's consumable goods been connected via a communication network (See Column 5, Lines 15-17) and a computer having therein a display displaying a the condition of the consumable goods of the printer (See Column 5, Lines 20-23) and further the server upon determining the situation of the consumable goods transmitting a an electronic filling document showing condition of the consumable goods related to the monitored printer (See Figure 4, Column 5, Lines 36-39).

As per claim 17, Hayward disclosed the server of the consumable goods providing side sending an offer to the standalone computer offering to purchase replacement of the consumable goods according to the measured or sensed level and displaying the information required to complete the order transaction (See Column 2, Lines 46-51 and 46-51).



**Claim Rejections - 35 USC § 103**

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 5-8 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hayward et al. (U.S. Patent Number 6,798,997) in view of what would have been obvious to one of ordinary skill in the art at the time the invention was made.

With respect to the rejection made above, Hayward substantially disclosed the invention as claimed. However Hayward was silent about forming a group out of a franchiser and franchisees and inquiring neighboring franchisee when one fails to have the equivalent level of consumable goods required, forwarding the substitute recycling with same or nearly same level.

An artisan working with the invention of Hayward related to method/system for automatically providing a consumable goods such as toner and other consumable goods used by a printer and

Art Unit: 2144

the like, by detecting the consumption level of the consumable goods and scheduling delivery of such goods according to the monitored condition of the consumable goods, would have been aware that such a method of doing business commonly involves recycling the recyclable and requesting additional goods from another franchisee or partner supplier or provider in order to supply the requested goods to the requesting consumer. Thus, it is respectfully submitted that it would have been obvious to one of ordinary skill in the art at the time the invention was made to include such a feature believed to be within a common knowledge of one skill in the art or a fundamental procedure or feature in the art of providing consumable goods business (forming a group out of a franchiser and franchisees and inquiring neighboring franchisee when one fails) and have modified the teachings of Hayward related to providing consumable goods in order to smooth the progress of providing service to the consumer.

6. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hayward et al. (U.S. Patent Number 6,798,997) in view of Graves et al. (US H001743 H) hereinafter referred to as Graves.

Art Unit: 2144

Hayward substantially disclosed the invention as claimed, but failed to teach scheduling delivery of the consumable goods according to past/historical record. However, as evidenced by Graves, scheduling delivery according to historical record or usage was known in the art at the time the invention was made. See Column 2, Lines 25-34 and Column 4, Lines 46-62. Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to take the teachings of Graves related to scheduling delivery based on past usage and have modified the teachings of Hayward related to providing a consumable goods because such a modification would ensure adequate supply delivery to the consumer. See Column 1, Lines 19-25.

#### Conclusion

7. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

- a. Sekizawa (US 6430711 B1) entitled: "System and method for monitoring the state of a plurality of machines connected via a computer network"
- b. Manchala et al. (US 6405178 B1) entitled: "Electronic commerce enabled purchasing system"

Art Unit: 2144


c. Kageyama (US 6333790 B1) entitled: "Printing system wherein printer connected to one computer is managed by another computer over a network"

8. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Yemane Gerezgiher whose telephone number is (571) 272-3927. The examiner can normally be reached on Monday- Friday from 9:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful. The examiner's supervisor, William Cuchlinski, can be reached at (571) 272-3925.

YMG

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